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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Dental, Inc.

Serial No. 74/651,845

Paul Grandinetti of Levy, Zito & Grandinetti for Valley
Dental, Inc.

Dominic J. Salemi, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before **Cissel**, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-identified application was filed on March 27,
1995, seeking registration on the Principal Register of the
mark "TOOTH TOTS CLUB" as a service mark for "promoting
dental services and dental health," in Class 42. Applicant
claimed first use and use in interstate commerce since
January 4, 1988, and stated that the mark is used "by
printing it on signs, brochures, booklets, letterhead,
labels, bulk mail, novelty items, and custom printed
products[,] by broadcasting on radio and television, and by

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other ways customary in the trade." The application included as specimens photocopies of the page shown below.

The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the term sought to be registered because "they contain no reference to a service." The Examining Attorney cited Trademark Rule 2.58 and required specimens which showed the term sought to be registered used to identify the services set forth in the application. Additionally, that recitation of services was found to be indefinite because the "method" by which applicant promotes dental health and dental services was not specified. Amendment to the recitation was required, and the Examining Attorney suggested that applicant amend to state that the promotion was rendered "through personal visits by a costumed character."

Applicant responded by amending the application to restate the services as "promoting dental services and dental health through informative promotions," in Class 42. Applicant offered the following explanation of how the mark is used in connection with its services: "The applicant promotes its dental services and dental health through informative promotional material that is oriented to children. The promotions are signs, brochures, and advertisements and include characters in stories and/or cartoons that promote good dental practices."

Submitted with this explanation were twenty-three declarations from applicant's customers. In each, the

declarant avers that he or she is familiar with applicant's advertisements for its services of promoting dental health and dental services, as well as a number of the marks applicant seeks to register. Each declarant further asserts that he or she has come to associate the services provided by applicant with various specified marks, including the mark "TOOTH TOTS CLUB."

Following the reinstatement of the application after it had been improperly held abandoned when applicant's response was not timely associated with the application file, the Examining Attorney made the requirement for substitute specimens final with the second Office Action. Applicant was again advised that the specimens of record were "unacceptable as evidence of actual service mark use because they contain no reference to a service." Trademark Rule 2.58 was again cited as the basis for the requirement for substitute specimens. Again the Examining Attorney required amendment to the recitation of services because the existing one was found to be indefinite, and again he suggested adoption of the following wording: "promoting dental services and dental health through personal visits by a costumed character."

On December 20, 1996, applicant appealed. Submitted concurrently with the notice of appeal was an amendment to the recitation of services. The application was amended to

specify the services as "promoting dental health to children."

Also included were substitute specimens, supported by a proper declaration as to use at least as early as the filing date of the application. The specimens are copies of pages from a promotional brochure which applicant states is given to children as part of the service of promoting dental health. The first page is titled "the Adventures of Myrtle Molar and the Tooth Tots!" It shows the same group of tooth-shaped cartoon characters which are pictured on the original specimens, along with a larger version of the one labeled "MYRTLE MOLAR" depicted holding a membership card for the "Tooth Tots Club." The next page informs the reader that the Tooth Tots Club is "for kids age 2-12." One caption reads "Hey Kids! Join the Tooth Tots Club Today. You'll get FREE Gifts, FREE Games, and unlimited FUN!" The third page of the brochure shows the group of tooth characters as "The Tooth Tots," and they are appealing to readers to "Join me and my friends in the Tooth Tots Club"; "Bring in this Coupon"; "Get Your Membership Card Today"; "Get Your Free Fun Pack!" A coupon is provided which entitles the bearer to a free exam and free club membership. The final page appears to be the cover of the mailer for the "Tooth Tots Club." It features the words "Tooth Tots Club," as well as the images of the five tooth-shaped cartoon

characters which are shown in the original specimens. Each page of the promotional brochure prominently features applicant's name, "VALLEY DENTAL."

The Board instituted the appeal, but suspended action on it and remanded the application file to the Examining Attorney for consideration of the amendment, the new specimens, and the arguments which accompanied them.

The record does not reflect action by the Examining Attorney on the remanded application, however. Applicant filed its brief on February 18, 1997. The Examining Attorney's undated brief in response was subsequently entered into the record, and applicant filed a reply brief, but did not request an oral hearing. Because the Examining Attorney's brief appears to take into account the amended recitation of services and the additional specimens, we are considering this appeal now as if the Examining Attorney had timely responded to the Board's remand order by reconsidering the application and then maintaining the requirements for new specimens and an amended recitation of services.

Based on careful consideration of the record in this application, as well as the pertinent legal authorities, we hold that the requirements for different specimens and an amendment to the recitation of services are unnecessary. This application is in condition for publication. The

specimens applicant has submitted are acceptable evidence of applicant's use of the term it seeks to register as a service mark for the services set forth in the application, as amended, and that amended recitation of services is not unacceptably indefinite.

We note for the record that we are disregarding the language from the Examining Attorney's brief to the previously unmentioned "refusal made pursuant to Sections 2, 3 and 45 of the Trademark Act." We are interpreting his words concerning those sections of the Act as simply another way of characterizing the issue which was raised by the Examining Attorney in every Office Action and his brief, and which was argued by applicant in every response and in its appeal brief, i.e., whether the specimens show the mark sought to be registered used as a service mark to identify the services set forth in the application, as amended.

At the outset of our discussion of the merits of this appeal, we should address the issue of the requirement for a more definite recitation of applicant's services. As amended, the services are stated as "promoting dental health to children." We fail to see anything "indefinite" about this recitation. The service, the activity performed for the benefit of others, is plainly stated as the promotion of dental health. Applicant goes on to state that the service is rendered to children, although that aspect of the service

is not as significant as the promotional activity itself. "Promoting dental health to children," or even just "promoting dental health," is a definite statement identifying the service applicant provides. It is unnecessary to specify the means by which this is accomplished. In any event, we can see no legal, logical, or evidentiary basis for the Examining Attorney's repeated suggestion of an amendment stating that applicant promotes dental services and dental health "through personal visits by a costumed character." It eludes us why promotion through visits by a costumed character would be acceptable, but promotion the way applicant does it, through the use of cartoon characters in a variety of printed materials given to children, would not be.

In summary, the existing recitation of services is acceptable. We note for the record that if applicant were only promoting its own services under the mark, registration of "TOOTH TOTS CLUB" as a service mark for these promotional services would not be proper because it is not a service to promote one's own services. This is apparently not the case, however. Applicant promotes dental health to children in general, rather than its own children's dental services in particular. In any event, the Examining Attorney has never refused registration on the basis that what applicant

does under the mark is not a service because applicant is only promoting its own services.

As indicated above, we find that the specimens do show that applicant uses "TOOTH TOTS CLUB" as a service mark for applicant's service of promoting dental health to children. The Examining Attorney argues that the specimens of record are unacceptable because they do not specifically mention the promotion of dental health to children. The mere fact that the specimens of record do not specifically state that applicant offers "TOOTH TOTS CLUB children's dental health promotional services," however, does not disqualify the specimens.

Section 1 of the Lanham Act provides for the registration of marks used in commerce to identify services, and paragraph (A)(1)(C) of that section requires that specimens or facsimiles of a mark as used must be submitted along with the application, drawing and fee. The Court of Customs and Patent Appeals, in *In re Universal Oil Products Company*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), discussed the requirement of Section 45 of the Act that in order to be registered as a service mark, a mark must be used in the sale or advertising of services. In his opinion in that case, Judge Rich, citing *Ex parte Phillips Petroleum Co.*, 100 USPQ 25 (Com'r. Pats. 1953), noted that the specimens in

an application must show a "direct association" between the offer of services and the mark sought to be registered.

An example of how this standard can be met is provided in the more recent case of *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). There, the Court took into account the specimens of record, as well as affidavits from purchasers of the applicant's services stating that they considered the mark sought to be registered to identify the services specified in the application. The Court concluded that the specimens submitted with the application showed the mark used to identify the services named in the application.

The situation in the case now before us is clearly analogous to that one. Here, the specimens, especially the substitute ones, show the mark sought to be registered used in materials which applicant provides to children as part of the service of promoting dental health. The cartoon characters inviting children to join the "TOOTH TOTS CLUB, the membership card bearing the mark, and the other illustrations referring to the group of tooth-shaped cartoon characters as the "TOOTH TOTS CLUB" all show the term sought to be registered in ways obviously intended to create in a child's mind a friendly and inviting image for having dental health maintained through the use of dental professionals like applicant. Applicant has explained that these

materials are distributed to children in connection with the services of promoting dental health. Moreover, these services are provided without charge to educational and other institutions, and the services are also performed at applicant's dental clinics for children.

Thus, applicant has shown that the materials bearing the "TOOTH TOTS CLUB" mark are used as part of its program to promote dental health. The direct association in the mind of a child receiving these materials between "TOOTH TOTS CLUB" and the advantages of having healthy teeth by getting dental care is plainly established by the record.

Further, just as in the Advertising & Marketing Development Inc. case, supra, not only are we presented with these unambiguous examples of the use of the mark in the kinds of ways such a mark would be used in connection with the specified service, we also have statements from a number of the purchasers of the services that they have come to associate the services of applicant with the mark. While this would not be persuasive evidence without specimens which show the mark used in connection with the services, this evidence confirms what the specimens establish, that applicant uses the mark in ways that create a direct association in the minds of purchasers between the mark and the services.

In summary, the recitation of services in this application, as amended, is sufficiently definite, and the specimens of record show the mark sought to be registered used in connection with the rendering of the specified services.

Accordingly, the requirements for additional specimens and amendment to the recitation of services are reversed, and the application will proceed to publication.

R. F. Cissel

E. J. Seeherman

E. W. Hanak
Administrative Trademark Judges
Trademark Trial & Appeal Board